

REMARKS/ARGUMENTS

Claims 51-70 are pending in this application. By this Amendment, dependent claims 57 and 58 have been amended to remove the words "the step of". This is being done to avoid any implication that claims 57 and 58 are "step plus function" claims under 35 U.S.C. § 112, sixth paragraph.

In the final Office Action mailed on May 21, 2003, the Examiner withdrew the previous rejection of claim 33 under 35 U.S.C. § 102(b) over U.S. Patent No. 4,877,134 (Klein), as well as the previous rejection of claims 34-50 under 35 U.S.C. § 103(a) over Klein '134 in view of U.S. Patent No. 5,609,778 (Pulaski et al.), in view of the Applicants' submission of new claims 51-70 reciting first and second databases for storing container and sample information, respectively. However, new claims 51-61 have now been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Klein '134 patent in view of a newly cited reference, Japanese Patent Publication No. 08-3044140 (Susumu et al.). In addition, new claims 62-70 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Klein '134 in view of Susumu et al. as applied to claims 51-61, and further in view of the Pulaski et al. '778 patent. These new rejections are respectfully traversed.

As pointed out in the previous Amendment filed by the Applicants on February 24, 2003, there is no indication that the bar codes shown in Fig. 4 of the Klein '134 patent are *universally unique* in the sense intended by the present invention. ("Unique" means that no two containers have the same identifying marking, while "universal" indicates that the uniqueness of the identifier is preserved across institutional or organizational boundaries.) Therefore, the Klein '134 patent is deficient not only in failing to disclose the first and second databases of Applicants' claim 51, as the Examiner has conceded in the latest Office Action, but also in failing to disclose the use of a universally unique identifier as recited in the claim.

These two seemingly unrelated deficiencies of the Klein '134 are, in fact, related. In the present invention, the recited "first database" -- the database which stores information relating to the container -- provides a mechanism by which the universal uniqueness of the container identifier can be assured. (See, e.g., the description of the preferred embodiment at page 21, lines 8-20 of the specification.) If universally unique identifiers are not required, the first database may likewise not be required. One must assume that this is the case in the Klein '134 patent, since neither feature is mentioned.

The Susumu et al. reference does not remedy these deficiencies of the Klein '134 patent. Susumu et al. discloses in Fig. 2 a specimen container processing system in which a specimen container 1 bearing a bar code 2 is scanned by a bar code reader 11. A host computer 13 receives the bar code data, which consists of patient identification information, and uses it to retrieve from a database 17 detailed information about the patient whose specimen is contained in the container 1. If the database 17 indicates that the patient has an infectious disease, the host computer causes an inkjet printer 18 to print a distinctive mark on the specimen container 1 or on another container 1' into which the specimen has been transferred. The mark provides a visual indication that the specimen container contains an infectious agent, which facilitates safe handling of the container.

The combination of Klein '134 and Susumu et al. does not lead to the present invention as defined in independent method claim 51. Even putting aside the question of whether the Klein '134 patent discloses universally unique identifiers (which the Applicants maintain it does not), the combination of Klein '134 and Susumu et al. does not result in *first and second databases* as specifically recited in independent claim 51. The Klein '134 patent does not mention databases at all; however, even if it can be assumed that the purpose of the bar codes of Klein '134 is to provide a link to information in an undisclosed database, such information would clearly be information about the samples rather than information about the test tubes themselves. The Susumu et al. reference mentions only a single database 17 which, again, contains only sample (or patient) information rather than container information. Thus, nowhere in the

proposed combination is there any database corresponding to the "first database" recited in Applicants' independent claim 51.

The Examiner states in the Office Action that it would have been obvious to one of ordinary skill in the art to utilize a database containing container information. However, in the absence of a specific suggestion in the prior art to provide such a database, this feature of the present invention cannot be regarded as obvious. See M.P.E.P. § 2143.03 ("To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art"). As noted above, the container information database provides a mechanism by which the universal uniqueness of the container identifiers can be assured. Universal uniqueness is not discussed at all in the Klein '134 or Susumu et al. references, and hence the use of a container information database as a way to assure universal uniqueness cannot be regarded as obvious in view of those references.

The Examiner states in the Office Action that "[b]ecause Klein teaches that barcodes are associated with the individual tubes and later associated with the contents of the tubes, it would have been obvious to one of ordinary skill in the art to have two databases -- one for the tubes themselves and one for the contents of the tubes". The Applicants respectfully submit that this reasoning is the product of hindsight and that it does not follow from the teaching of the Klein '134 patent itself. If the object is simply to provide the test tubes 10 of the Klein '134 patent with sequentially numbered bar code labels, this can be achieved with a sequential or variable printer. It does not require a database, and certainly not one that stores information relating to the test tube to which the bar code label is applied. A container information database becomes useful when universally unique bar codes are desired, a concept which is absent from the Klein '134 patent.

The Pulaski et al. '778 patent, relied upon by the Examiner in the rejection of dependent claims 62-70, is relevant only for its disclosure of laser marking of glass and plastic surfaces. It does not suggest the use of universally unique container identifiers or of first and second databases containing container and sample information, respectively.

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The Examiner's reconsideration and withdrawal of the final rejection, and allowance of claims 51-70, is respectfully requested in view of the amendments and remarks presented herein. Should the Examiner wish to discuss this application with the applicant's representative, she is invited to contact the undersigned attorney at the local telephone number listed below.

Respectfully submitted,



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